

## REMARKS

### I. Status of the Claims

Claims 349-351, 353-360, 362-370, 384-392, 394-398, and 400-403 are pending. By this amendment, Applicants have canceled the claims directed to the composition, i.e., claims 324-326, 328-338, 340-348 without prejudice or disclaimer to the subject matter disclosed therein. Applicants have amended the remaining independent claims to include the subject matter of claims 352, 354, 361, and 363, indicated as allowable by the Examiner in the Supplemental Office Action mailed September 2, 2004, i.e., the mercapto alkanol ester of a carboxylic acid having the formula  $R^a\text{COOR}^b\text{SH}$  where  $R^a$  is a linear or branched alkyl or alkenyl, aryl or aralkyl; and  $R^b$  represents a  $C_2$  to  $C_{18}$  alkylene. Therefore, support for this amendment can be found, for example, in the canceled claims 352 and 361, as well as in pending claim 390.

As discussed with the Examiner during a teleconference on January 21, 2005, Applicants have amended claims 384-392, 394-398, 400, and 401 from composition claims to method claims. These claims recite the same "method" language as the other method claims (see, e.g., claims 349 and 358), including the allowable subject matter directed to the mercapto alkanol ester of a carboxylic acid having the formula  $R^a\text{COOR}^b\text{SH}$ . As the Examiner indicated during the January 21<sup>st</sup> conference call, these claims should be in condition for allowance for the same reasons that the other methods claims are in condition for allowance.

Applicants have also added new claims 402 and 403 directed to carboxylic acid as comprising at least one natural fatty acid present in peanut oil, tall oil, safflower oil, soybean oil, tallow, lanolin, palm oil, or coconut oil. Support for these new claims can be found in canceled claims 367-370. By this amendment, Applicants are merely

reciting in the pending methods claims subject matter that was previously recited in the composition claims. As the independent claims from which claims 402-404 depend are allowable, new claims 402-404 should also be allowable.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing all the pending claims in condition for allowance.

Applicants submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were earlier claimed, as examined.

Therefore, this Amendment should allow for immediate action by the Examiner.

## **II. Status of Composition Claims**

Applicants greatly appreciate the Examiner's willingness to discuss the status of the application, including proposed claim amendments, in multiple teleconferences with Applicants' undersigned representative. As discussed during the teleconference on January 21, 2005, in an effort to advance prosecution, Applicants have canceled the composition claims on the assumption that the pending method claims, which now contain the allowable subject matter noted on page 1 of the September 2, 2004 Supplemental Office Action, will be allowed. If this amendment does not result in an allowance of the pending claims, Applicants hope that the Examiner would reenter the composition claims to preserve them for any future appeal. While Applicants understand that the re-entry of the composition claims may not be typical at this stage of prosecution, they believe that the unusual nature of this case, including the extremely long and costly prosecution spanning a quarter of a century, justifies such a request.

**III. Rejections Under 35 U.S.C. §112, second paragraph**

The Examiner's rejection of claims 380 and 393 has been rendered moot by the cancellation of these claims.

**IV. Double Patenting Rejection**

The Examiner has maintained and made final the rejection of claims 324-348, 367, 368, and 371-401 under the judicially created doctrine of double patenting as being unpatentable over claims 11-16 of U.S. Patent No. 4,412,897 to Kornbaum et al.

("Kornbaum"), further in view of the following new references, U.S. Patent No. 4,093,484 to Harrison et al. ("Harrison"), U.S. Patent No. 4,278,518 to Bjellqvist et al. ("Bjellqvist"), and U.S. Patent No. 4,060,508 to Sugahara et al. ("Suguhara").

Applicants continue to respectfully disagree with this rejection for the reasons of record, and preserve such arguments for appeal, if necessary. However, the above amendment renders the double patenting rejection moot. Thus, Applicants request that this rejection be withdrawn.

**V. Prior Art Rejections**

The following three rejections were addressed in the final Office Action mailed June 4, 2004 (and the Supplemental Office Action of September 2, 2004). Applicants assume that the rejections previously made and not addressed in the final Office Action have been withdrawn.

**a. Rejections Under 35 U.S.C. §102(e)**

The Examiner has maintained and made final the rejection of claims 324-326, 335-338, 347-351, 353, 355-360, 362, 364-370 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 4,115,352 to Bohen ("Bohen") for the reasons of record. While Applicants continue to disagree with the Examiner's assertions for the reasons of record, the above amendment renders this rejection moot. Applicants thus request that this rejection be withdrawn.

**b. Rejections Under 35 U.S.C. §102(b)**

The Examiner has maintained and made final the rejection of claims 336-338, 347, 348, 358-360, 362, 364-366, 368, 370-372, 374-379, 381, 382, 384, 385, 387-392, 394, 395, 397, 398, 400, and 401 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,062,881 to Kugele ("Kugele"). While Applicants continue to disagree with the Examiner's assertions for the reasons of record, the above amendment renders this rejection moot. Applicants thus request that this rejection be withdrawn.

**c. Rejections Under 35 U.S.C. §103**

The Examiner has maintained and made final the rejection of claims 336-338, 347, 348, 358-360, 362, 364-366, 368, 370-372, 374-379, 381, 382, 384, 385, 387-392, 394, 395, 397, 398, 400, and 401 under 35 U.S.C. §103(a) as being unpatentable over at least one of U.S. Patent No. 2,870,182 to Leistner et al. ("Leistner '182") or U.S. Patent No. 2,914,506 to Mack ("Mack"), or U.S. Patent No. 3,931,263 to Molt ("Molt"), in view of U.S. Patent No. 2,460,436 to Shoemaker et al. ("Shoemaker"). While Applicants continue to disagree with the Examiner's assertions for the reasons of record, the above

amendment renders this rejection moot. Applicants thus request that this rejection be withdrawn.

**VI. Conclusion**

In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of the outstanding rejections, and the timely allowance of the pending claims. The Examiner is invited to contact Louis Troilo at (202) 408-6020, if this response does not place all the claims in condition for allowance, or if any matter may be resolved by a telephone conference.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

***/Louis Troilo/***

By: \_\_\_\_\_  
Louis M. Troilo  
Reg. No. 45,284  
Phone: 202-408-6020

Dated: February 2, 2005